



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/344,350	01/29/82	COLBRY	N

STEPHEN I. MILLER
201 TABOR ROAD
MORRIS PLAINS, NJ 07950

EXAMINER	
TURNIPSEED, J	
ART UNIT	PAPER NUMBER
122	

DATE MAILED: 08/25/82

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined. Responsive to communication filed on _____ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892 2. Notice of Informal Patent Drawing, PTO-948
3. Notice of References Cited by Applicant, PTO-1449 4. Notice of Informal Patent Application, Form PTO-152

Part II SUMMARY OF ACTION

5. _____

1. Claims 1-8 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 1-8 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. The formal drawings filed on _____ are acceptable.

8. The drawing correction request filed on _____ has been approved. disapproved.

9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has
 been received. not been received. been filed in parent application, serial no. _____,

filed on _____.

10. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

11. Other

Art Unit 122

The references cited but ^o copy of which is not supplied was cited and supplied in the parent file. The additional references are cited to show the state of the art.

^{OK} The requirement is made for the insertion of the status of the application inserted at page 1 of the specification.

The disclosure is objected to as failing to comply with the best mode requirement as required by the first paragraph of 35 U.S.C. 112. This paragraph of the statute, requires that the specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

There is no adequate showing that the compounds of the instant claims can be used in treating tumors and psoriasis as is recited in the "Abstract of the Disclosure and at page 9, forth paragraph to page 10, the last two paragraphs thereon. Note MPEP 608.01 (p). Applicant is required to either cancel the references to treating tumors and psorias from the specification or to present some evidence, either direct or indirect

to support the use of treating mammals, especially humans, with the compounds of the instant claims.

66 Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the preceding paragraph(s).

Claims 1-8 are rejected under 35 U.S.C. 103 as being unpatentable over Elslager, et al. Although, the invention is not identically disclosed or described as set forth in section 102 of Title 35 U.S.C., the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Elslager, et al discloses the free base of the instantly claimed compounds and teach at page 2, col.2 that salts thereof may be formed with organic acids. Although applicant teach that the compounds of the instant claims are more soluble in water than other salts of the free base, this alone is not deemed to be sufficient to render the instantly claimed compounds patentable over the free base, especially in view of the common utility and further since it is well known in the art that drugs are commonly used in the form of their salts, as is taught by Berge, et al and further since it is well known that some salts have greater

Art Unit 122

solubility than others as is taught by
McElvain. Therefore, the compounds of the instant claims would be readily suggested to one of ordinary skill in the art, especially in the absence of some unexpected property or results.

Claim 9 is rejected under 35 U.S.C. 103 as being unpatentable over Elslager, et al. Although, the invention is not identically disclosed or described as set forth in section 102 of Title 35 U.S.C., the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Elslager, et al disclose the process of the instant claim employing analogous reactants. The instantly claimed process would be readily suggested to one of skill in the art.

Claims 1-9 are rejected.

This application is a continuation application of an earlier application. Further, all claims are: (a) drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application.

Accordingly, THIS OFFICE ACTION IS PROPERLY MADE

FINAL even though it is a first action in this case.
See MPEP 706.07(b).

Turnipseed:cvm

A/C 703

557-3032

8/19/82



J. G. Dous
Supervisory Patent Examiner
Art Unit 122